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EXAMINER
LAUFER, P

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ART UNIT PAPER NUMBER

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DATE MAILED: 07/25/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 6-7-95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 1-26 are pending in the application.
Of the above, claims are withdrawn from consideration.
- ☐ Claims have been cancelled.
- ☐ Claims are allowed.
- ☒ Claims 1-26 are rejected.
- ☐ Claims are objected to.
- ☐ Claims are subject to restriction or election requirement.
- ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ; filed on
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

Part III DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-3, 5, 8-12, 14-16, 18, and 21-25 are rejected under 35 U.S.C. § 102(e) as being anticipated by Stringer ('429). With respect to claim 1, (a) "selectively disabling" is met by the disabling after the authorized period or number of times of use has taken place, and (b) the counter for each software application is interpreted as the claimed "code ... which contains information on sampling". Time limited use (claim 8) is found at column 3 line 56; preventing enabling after a predetermined number of samples (claim 5) is found at column 4 lines 2-9 and column 8 lines 65-69; encryption/decryption (claim 9) is found at column 9 lines 14-24; displaying the icon (claim 10) is found at column 10 lines 60-64 and column 11 line 61; receiving from non-volatile medium (claim 11) is found at column 4 lines 41-57; and unlocking upon purchase (claim 12) is found at column 3 line 60 and column 4 lines 33-40.

3. Claims 1, 5, 11-13, 14, 18, and 24-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hellman ('093). With respect to claims 1 and 13, (a) "selectively disabling" is met by the disabling after the authorized period or number of times of use has taken place, and (b) the claimed "code ... which contains information on sampling" is met by the authorization code because it contains information as to how many times sampling is authorized, and (c) "unlocking" of claim 13 is interpreted as enabling access.

4. Claims 1, 2, 11, 14, 15, and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Thomas ('519). With respect to claim 1, the software is precluded from unauthorized copying in that the copies are useless to unauthorized users; selective disabling takes place when the code does not match; and the coded response is related to the specific software. With respect to claim 11, the hard drive is non-volatile memory.

5. Claims 1-2, 5, 8-9, 14-15, 18, and 21-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Best ('901). When a user selects the program to be executed, the system monitoring the input (e.g. keyboard) generates a code indicating which storage areas the encrypted software is stored in. Thus, the claim 1 monitoring means "which identifies a particular software program" is inherent to Best. Timer and counter are found at column 7 lines 28-35.

6. Claims 1-2, 10-12, 14-15, and 23-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ogaki ('799). The selective disablement is done by reset key (13) found at column 4 line 1, and the icon is found at column 3 lines 35-38. The software is in the locked state while being executed on the vending machine display since there is no way to make an unauthorized copy.

7. Claims 1-3, 5, 9, 12, 14-16, 18, 22, and 25 are rejected under 35 U.S.C. § 102(e) as being anticipated by Singh ('563). The selective disablement is found at column 8 line 43, the monitoring means generates new random files including trial number (see column 6 lines 30-43).

8. Claims 1-3, 5, 8-9, 11, 14-16, 18, 21-22, and 24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Comerford ('413). The selective disablement is identified with the software return procedure described in columns 29-30. Sampling information is stored in encrypted form (column 3 lines 58-62). Limiting use to time or number of trials (claims 5 and 8) is found at column 2 lines 23-30.

9. Claims 1-3, 5, 9, 11, 12, 14-16, 18, 22, 24, and 25 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hornbuckle ('211). Usage during rental is interpreted as sampling, selective disablement is described in the first paragraph of column 14, trials and purchases are found at column 4 lines 4-10.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this

section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

11. Claims 7 and 20 are rejected under 35 U.S.C. § 103 as being unpatentable over Stringer ('429), or Hellman ('093), or Best ('901), or Comerford ('413). The primary references do not teach displaying the number of samples remaining. It would have been obvious to implement any of the primary references with the display this number (which is available) because awareness of the number of remaining trials acts as an inducement to the potential buyer to decide whether to purchase additional access and to avoid alienating a legitimate customer by rendering the program inoperative without forewarning.

12. Claims 4 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Ogaki ('799). Ogaki teaches maintaining records of the usage and sale of each software item and transmitting this information to the central host (column 6 lines 48-50). Ogaki also teaches separating the software offerings by category (column 3 lines 42-45). Therefore, it would have been obvious at the time of the invention to process the information to determine the most frequently requested category (or any other financial information) because this enables the vendor to make decisions regarding resource allocation.

13. Claims 4 and 17 are rejected under 35 U.S.C. § 103 as being unpatentable over Ogaki ('799) in view of Suzuki ('050). Ogaki teaches maintaining records of the usage and sale of each software item and transmitting this information to the central host (column 6 lines 48-50). Ogaki also teaches separating the software offerings by category (column 3 lines 42-45). Ogaki does not teach calculating frequency. Suzuki ('050) teaches replacing software programs in the vending machine based on the frequency of duplication. In light of Suzuki's teaching, it would have been obvious to implement Ogaki with frequency determination to allow the vendor to dedicate more storage to the categories of items that are in demand.

14. Claims 6 and 19 are rejected under 35 U.S.C. § 103 as being unpatentable over Stringer ('429), or Hellman ('093), or Best ('901), or Comerford ('413), or Singh ('563), or Thomas ('519), or Ogaki ('799) in view of Tobin ('890). Tobin ('890) teaches disabling the program if comparison of counters indicates that an attempt to get around the system has occurred. (bottom of column 8). It would have been obvious to modify each of the primary references to include means for detecting whether unauthorized duplication is attempted and disabling the sampling in response because of the motivations presented in the references - that is, the desire to protect the software supplier from unfair use of the product.

15. Molnar ('668) can not "subsequently sample"; Uchenik ('315) deals with a single software application; Wiedemer ('928) is designed for a single software application; Tobin ('890), does not have the monitoring means to generate a code "which identifies a particular software program .."; Suzuki ('171) is a vending system which keeps detailed utilization records for users and

software; Mori ('392) maintains detailed records for billing purposes. Thomas ('055) teaches the collection of marketing data and transmitting the data to a host processor. Schull ('070), Shear ('508), Katznelson ('571), Ananda ('411), Hon ('810), and Hughes ('710) are considered pertinent to applicant's disclosure.

Specification

16. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

17. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Information Disclosure Statement

18. The information disclosure statement filed 7 June 1995 fails to comply with 37 CFR § 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, *but the portion of the information referred to therein which does not comply (copies not supplied) has been crossed off the list and has not been considered as to the merits.*


Information Regarding Communication with the PTO

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 7:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. T. Tarcza, can be reached on (703) 306-4171. The fax phone number for this Group is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-4177.

Pinchus M. Laufer
July 22, 1996
PML


THOMAS H. TARCZA
SUPERVISORY PATENT EXAMINER
GROUP 2200